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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,398	03/15/1999	MASAHIRO SHIOJI	990264	6994

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EXAMINER

WHIPKEY, JASON T

ART UNIT PAPER NUMBER

2612

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,398

Applicant(s)

SHIOJI ET AL.

Examiner

Jason T. Whipkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Period for Reply

1. The following action was previously mailed. However, due to a mailroom error, the mailing date listed on the cover sheet was incorrect. Since the exact date of mailing is indeterminate, the mailing of this action will restart the period for reply.

Restriction

2. Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Drawings

3. The replacement drawing sheet was received on August 7, 2003. This drawing is approved and the corresponding objection is withdrawn.

4. The amendment to the specification to obviate the objections to the drawing. The objections to the drawings are withdrawn.

Specification

5. The new title is approved and the corresponding objection is withdrawn.

Claim Objections

6. The amendments to claims 4 and 20-22 to overcome the objections to these claims are approved and the objections are withdrawn.

Response to Arguments

7. Applicant's arguments filed August 7, 2003 with regard to claim 1 have been fully considered but they are not persuasive.

Applicant attempts to overcome the rejection under 35 U.S.C. § 102(e) over Kato by amending claim 1. However, the amended claim is still anticipated by Kato. Kato shows in Figure 2 that current imaging visual field 44 "is formed at a first point in the top left position of the monitor frame and a second point in the bottom right position of the monitor frame to form a rectangle", as recited in claim 1. A frame is formed on the screen at a *location* selected by an instruction from the user (i.e., a "frame forming instruction"), which in Kato's disclosure is inputted by determination designating unit 28 (column 5, lines 14-19).

While the examiner conjectures that Applicant is trying to claim an apparatus wherein the user selects the exact two points that are to form the rectangular image

frame, the claim language is still sufficiently broad as to enable it to read on Kato's disclosure.

Applicant argues on page 20 that Kato teaches that "the motion window provided at a region of the still picture is provided in accordance with the moving directions of the video camera. It differs from the method of the present invention by which a motion picture or a through picture is formed." The Applicant, however, fails to explain the difference. The examiner notes the determination designating unit 28 described above.

Applicant also argues that the rejection of claim 1 under 35 U.S.C. § 103(a) in view of Sarbadhikari is inappropriate because "[t]he size, position, and shape of the region displaying a captured image in the template are preset for each template, and cannot be set arbitrarily by the user as in the present invention."

The examiner asserts that no such limitation is recited in claim 1. The user can form a motion image frame simply by selecting a template from one of the many available. This action will cause a template to be formed on the user's display.

Applicant makes a similar argument in response to the rejection of claim 4.

The same arguments made above can be applied to claims 12, 13, 20, and 21.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato.

Regarding claim 1, Kato discloses a camera system (Figure 1) including a video camera 10, a display unit 22, and a determination-designating unit 28 for designating an image area (column 5, lines 4-18). As shown in Figure 2, this image area is rectangular frame 44, which is smaller than display unit 22 and shows live image data captured by camera 10 (column 8, lines 36-39). Display unit 22 therefore also acts as a motion image display means.

Regarding claim 8, a potential maximum visual field 42, which displays a still image held in storage unit 34 (Figure 2; column 8, lines 6-9), covers the screen. Storage unit 34 therefore acts as a recording medium, and its associated circuitry acts as a reproducing means. Using update designating unit 29, a user may request that the still image stored in memory be updated and re-read from memory (column 5, lines 15-18, and column 8, lines 12-19). Display unit 22 therefore forms and displays the stored still image.

Regarding claims 9 and 10, live-action frame 44 and still frame 42 may be displayed simultaneously (Figure 2) according to the manipulation of live-action frame 44 by the user via a mouse (column 7, lines 28-34, and column 8, lines 36-37).

Regarding claim 11, Kato teaches that while a user may move live-action frame 44, the still frame 42 in the background image will remain unchanged until the user requests a refresh (column 8, lines 10-14). After a still image is read from memory, the user is free to move live-action frame 44 around the screen (column 8, lines 12-24).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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12. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari.

Regarding claim 1, Sarbadhikari discloses a software-enhanced digital camera. As shown in Figure 2, the camera includes an exposure section 10 with an image sensor 12 (column 5, lines 59-61) and an electronic viewfinder 29 (column 7, lines 28-30). Digital processor 22 acts as a forming means and a motion image display means, as it provides images to viewfinder 29 (column 10, lines 30-36).

As shown in figures 8 and 9, the camera may be provided with a variety of templates that may surround a captured image (column 10, lines 24-28). A chosen template appears in viewfinder 29 to assist the user with framing an image that is to be inserted in the template (column 10, lines 39-43). As shown in Figure 9, the template fills the viewfinder's frame and surrounds a smaller user-captured image.

Additionally, Sarbadhikari claims in column 13, lines 3-6, an image sensing section "for electrically capturing an image provided by the optical section" and a signal processing section for processing this image. In lines 24-28 of the same column, this electrically captured image is combined with a pre-existing image file.

Still, Sarbadhikari is unclear as to whether or not the user-captured image is a moving image or a still image retrieved from memory.

However, since Sarbadhikari teaches the use of an electronic viewfinder — and considering that a viewfinder is only useful if it provides a constantly updated image, which allows the user to frame a shot — it would have been obvious for Sarbadhikari to combine the still template with a "live" image because such an operation would require

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less memory, since the user-captured image need not be stored in its full size before creating the synthesized image. For this reason, it would have been obvious at the time of invention to have Sarbadhikari perform framing by using the live image captured by exposure section 10.

Regarding claim 2, Sarbadhikari teaches that the template files are located on memory card 24 (column 10, lines 24-28). Included in the files are data indicating where the captured image will appear in relation to the displayed template image (column 10, lines 43-50). This information, which must inherently consist of size and position data, is therefore input from memory card 24. Digital processor 22 acts as a motion image frame forming means, as it provides images to viewfinder 29 (column 10, lines 30-36).

Regarding claim 3, Sarbadhikari shows in figures 8 and 9 that the frame containing the user-captured image is a rectangle. Since the camera is aware of where the user-captured image should be replaced with respect to the template (column 10, lines 43-50), it is inherent that at least one vertex coordinate of the user-captured image area of the template is stored in memory card 24.

Regarding claim 5, Sarbadhikari teaches that memory card 24 stores captured image data files via interface 26 (column 6, lines 37-40 and 54-56). This data includes the data from the user-captured image area of viewfinder 29 (column 11, lines 9-13).

Regarding claim 6, Sarbadhikari teaches that image data are stored in image files via interface 26 (column 6, lines 37-40 and 54-56). It is inherent that these files

include data from the user-captured area and some type of identifier, as the files would otherwise be useless to the camera.

Regarding claim 7, Sarbadhikari teaches that the camera may store a script that would direct the computer to correctly combine an image file and its associated template upon viewing, rather than storing the combined file (column 11, lines 5-9). Therefore, it is inherent that image size information is stored; otherwise, the template and captured image may not fit as the user specified.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari in view of Shibata.

Claim 4 may be treated like claim 1. Additionally, Sarbadhikari teaches that a captured image may be reduced for display with the template (column 11, lines 1-3). However, Sarbadhikari is silent with regard to reducing a moving image before capture and placing it in template.

Shibata discloses a teleconferencing system with a screen layout such as the one shown in Figure 4(c). This figure shows a still picture received from a remote station displayed simultaneously with a moving image captured by a camera 1 (Figure 1) at the local station. The locally captured image is reduced in size by minor-frame address generator 309, which generates skipped addresses for readout to thin the moving picture data (column 10, lines 12-17).

An advantage to displaying a reduced-size moving image is that more pertinent data may be displayed on a screen while still giving the user a complete view of the

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image captured by a camera. For this reason, it would have been obvious at the time of invention to have Sarbadhikari use a moving image reduction system, such as the one described by Shibata.

14. Claims 12, 13, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato in view of Sarbadhikari.

Claim 12 may be treated like claim 9. However, Kato is silent with regard to recording an image in a monitor frame as displayed.

Sarbadhikari teaches that user-captured images may be combined with established templates to create a new file, as shown in figures 8 and 9 (column 11, lines 5-8). Image data files are stored in flash EPROM memory card 24 (column 6, lines 54-59) when a user is satisfied with the resulting image.

An advantage to storing an image displayed on a screen as an image file is that a user may view the exact image that is to be stored. This preview prevents undesirable images from being discovered later. For this reason, it would have been obvious at the time of invention to have Kato store an image file representative of a screen-displayed image.

Regarding claim 13, Sarbadhikari teaches that image data are stored in image files via interface 26 (column 6, lines 37-40 and 54-56). It is inherent that these files include data from the user-captured area and some type of identifier, as the files would otherwise be useless to the camera.

Regarding claim 20, Kato discloses a camera system (Figure 1) including a video camera 10, a display unit 22, and a determination-designating unit 28 for designating an image area, which acts as a setting means (column 5, lines 4-18). As shown in Figure 2, this image area is rectangular frame 44, which is smaller than display unit 22 and shows live image data captured by camera 10 in a synthesizing mode (column 8, lines 36-39).

Kato is silent with regard to using a digital camera with a recording mode and means and a reproducing mode.

Sarbadhikari teaches that user-captured images may be combined with established templates in a digital camera to create a new file, as shown in figures 8 and 9 (column 11, lines 5-8). Image data files are stored in flash EPROM memory card 24 (column 6, lines 54-59) when a user is satisfied with the resulting image. Images stored on memory card 24 may be browsed by the user (column 10, lines 58-63).

An advantage to storing images on a recording means and later reproduced is that images may be viewed and used at a later time without the need for separate viewing equipment. For this reason, it would have been obvious at the time of invention to have Kato's system include an image recording mode and means and a reproducing mode, such as those described by Sarbadhikari.

Regarding claim 21, Kato teaches that manipulation of live-action frame 44 may occur by the using determination-designating unit 28 (operated by the user and acting as a drawing means) to designate an image area (column 5, lines 4-18). A user may

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move live-action frame 44 using designating units 24 and 26, which act as position adjusting means (column 8, lines 10-14).

Allowable Subject Matter

15. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No prior art could be located that teaches or fairly suggests a camera with a resizable frame designation that changes color when the user sizes it to a prescribed ratio.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason T. Whipkey, whose telephone number is (703) 305-1819. The examiner can normally be reached Monday through Friday from 9 A.M. to 6:30 P.M. eastern daylight time, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber, can be reached on (703) 305-4929. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communication and (703) 872-9315 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, whose telephone number is (703) 306-0377.

Response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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or faxed to the appropriate number above for communications intended for entry. (For informal or draft communications, please label "**PROPOSED**" or "**DRAFT**".)

Hand-delivered responses should be brought to the sixth floor receptionist of Crystal Park II, 2121 Crystal Drive in Arlington, Virginia.

JTW

JTW

November 14, 2003


WENDY R. GARBER
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